

REMARKS

Claims 1-13 are pending in this application. Claims 1 and 2 have been amended and claim 14 has been cancelled. Claims 3-6 and 9-13 have been previously withdrawn. The foregoing amendments are taken in the interest of expediting prosecution and there is no intention of surrendering any range of equivalents to which Applicant would otherwise be entitled in view of the prior art. In view of the comments made herein, Applicants request reconsideration of the claims.

Restriction/Election Requirement

Applicants would like to thank Examiner Ford for his consideration of traversal arguments made in the previous Office Action Response, mailed June 26, 2006, and his acknowledgement of rejoinder of the claims if it is determined that the withdrawn claims are found to be dependent upon an allowable generic claim.

Related Applications

In response to the previously submitted Information Disclosure Statement, the Examiner indicated that "a few" of the requested related U.S. Patent Applications have been cited for consideration. Applicants believe that they have fully and completely disclosed all relevant related U.S. Patent Applications to the Examiner. If the Examiner believes that this is not the case and that other relevant references may exist, Applicants request an indication, via telephone call or in response to this submission, what potential references the Examiner is referring to. It is the intent of the Applicant to fully disclose all relevant prior art documents to the Examiner for consideration.

Rejections under 35 U.S.C. §112

Claims 1, 2, 7, 8 and 14 are currently rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. More specifically, the term "selectively", in claims 1 and 2, are being rejected to for lacking support in the original specification. Also, claims 1 and 2 are being rejected based upon other additional features added in a previously submitted Response. Further,

claim 14 is being rejected for lacking claim support within the written description. Applicants respectfully disagree.

Without acquiescing to the formulated rejection, Applicants have amended claims 1 and 2 to remove the terms selectively. Claim 2 has also been amended to remove the rejected material to place the claim in condition for allowance in view of the comments made herein. With regards to claim 14, without acquiescing to the validity of the rejection to this claim, Applicants have cancelled this claim without prejudice or disclaimer of the subject matter contained therein. Applicants intend to pursue the subject matter of previously presented claims 1, 2 and 14 at a later date.

With regards to claim 1, the Examiner asserts that previously added features are not fully supported by the specification. Applicants respectfully disagree.

Applicants note that in paragraph 6 of the original disclosure, it is contemplated that the first coolant circuit includes an electrically driven compressor in which electric power is made available to the compressor independent from the rotation speed of a vehicle engine. In paragraph 22, written description further discuss that the electrical energy may be supplied to the compressor via a generator, which may be driven by an engine. One ordinary skilled in the art would recognize that during rotation of engine components, the vehicle is in an operation mode.

The written description also discloses, in paragraph 22, that the compressor may also be supplied with electricity from a battery. In paragraph 28, the specification further states that during stationary operating mode the generator may be supplied power through a low electrical power. One skilled in the art would appreciate that the battery used to supply the compressor may comprise the low electric power source, as compared to the generated driven by the vehicle engine. Applicants note that not only should the specification should viewed by one skilled in the art, but also, there is not a requirement that the subject matter of the claim is recited literally (there is no *in haec verba* requirement). *In re Oda*, 443 F.2d 1200, 170 USPQ 268 (CCPA 1971).

Applicants are of the opinion that the rejections under 35 U.S.C. §112, first paragraph, have been traversed and/or rendered moot.

Rejections under 35 U.S.C. §102 and §103

Claims 1, 2 and 14 are currently rejected under 35 U.S.C. §102 as being anticipated by U.S. Patent No. 6,059,016, to Rafalovich, or U.S. Patent No. 6,260,367, to Khelifa et al. Alternatively, claims 1, 2 and 14 are rejected under 35 U.S.C. §103 as being obvious based upon either Rafalovich or Khelifa et al. and in further view of U.S. Publication No. 2001/0015070, to Hara. Claims 7 and 8 are also rejected under 35 U.S.C. §103 as being obvious based upon either Rafalovich or Khelifa and in further view of PCT Publication No. WO 01/40005. Applicants respectfully disagree.

At the onset, the Examiner has acknowledge that both Rafaovich and Khelifa et al. lack teaching of selectively operating the air conditioner compressor by the battery when the vehicle is in a stationary mode and selectively operating the air conditioner compressor by the engine (through the engine driven generator) when the vehicle is in an operating mode.¹ However, the Examiner indicates that these claim features are functional and cannot be given weight in determining patentability. Alternatively, the Examiner indicates that the missing features of Rafaovich and Khelifa et al. are taught in Hara.

Applicants believe that, functional language can be used for distinguishing over prior art. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "A patent applicant is free to recite features of an apparatus either structurally or functionally." In re Schreiber, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997), also See In re Swinehart, 439 F.2d 210, 212, 169 USPQ 226, 228 (CCPA 1971) (" [T]here is nothing intrinsically wrong with [defining something by what it does rather than what it is] in drafting patent claims."). A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. See Manual of Patent Examining Procedures (MPEP) § 2173.05(g). Yet, choosing to define an element functionally, i.e., by what it does, carries with it a risk. The court in In re Swinehart, stated:

¹ See Final Office Action mailed August 25, 2006, p. 8.

where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

In re Swinehart, 439 F.2d at 213, 169 USPQ at 228, also see also In re Hallman, 655 F.2d 212, 215, 210 USPQ 609, 611 (CCPA 1981); In re Ludtke, 441 F.2d 660, 663-64, 169 USPQ 563, 565-67 (CCPA 1971). Also, a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all of the structural limitations of the claim, expressly or through inherency. See MPEP §2114.

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

In view of the foregoing legal precedent, it is believed that the rejection under 35 U.S.C. §102 is improper without the Examiner considering all of the limitations of the claims in determining patentability, including limitations which he believes to be functional. Accordingly, the Examiner is required to show where Rafalovich or Khelifa et al. teaches or inherently teaches an air-conditioning system which includes a generator for providing electricity to a compressor and/or a pump and an air-conditioning system which includes a battery for providing electricity to a compressor and/or a pump. Applicants believe the rejection under 35 U.S.C. §102 to claims 1 and 2 (and claim 14) have been traversed.

In regards to the rejections of claims 1, 2 and 14 under 35 U.S.C. §103 based upon Rafalovich or Khelifa et al. and in further view of Hara, Applicants believe that the addition of Hara does not teach the omitted items of Rafalovich or Khelifa et al. For example, with reference to claim 1, none of the references teaches an

electrically driven compressor which is provided electricity from a generator when the motor vehicle is in an operating mode and which is provided electricity from a battery when the motor vehicle is in a stationary mode. These features must be considered for patentability.

In response to the Examiner's assertion that, alternatively, Hara makes up for the deficiencies of Rafalovich or Khelifa et al., this is simply not the case. Hara clearly teaches a compressor that is mechanically driven, not electrically driven, and therefore does not receive electricity as recited in claim 1. Not only is this clearly described in the specification, but also, Fig. 1 clearly show compressor (2) being mechanically driven by V-belt (7) and/or drive pulley (5). In view of the acknowledged shortcomings of Rafalovich and Khelifa et al., the legal precedent requiring consideration of functional language and the deficiencies of Hara, Applicants assert the claim 1 is in condition for allowance.

In view of the foregoing, it is believed that the rejections to claim 1 have been traversed and claim 1 is now in condition for allowance. Similarly, dependent claims 2, 7 and 8, which are dependent upon claim 1, are also believed to be in condition for allowance.

By amending the application, the Applicants do not concede that the patent coverage available to them would not extend as far as the original claim. Rather, Applicants reserve the right to file a continuation application to pursue the breadth of the claims as filed. Applicants believe that the Examiner has not made a sufficient showing of inherency of the teachings of the asserted prior art, especially given the lack of teachings in the cited references of the properties that Applicants have recited in their claims.

Further, by the present amendment, it does not follow that the amended claims have become so perfect in their description that no one could devise an equivalent. After amendment, as before, limitations in the ability to describe the present invention in language in the patent claims naturally prevent the Applicants from capturing every nuance of the invention or describing with complete precision the range of its novelty or every possible equivalent. See, Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 62 USPQ2d 1705 (2002). Accordingly, the foregoing amendments are made specifically in the interest of expediting prosecution and there

is no intention of surrendering any range of equivalents to which Applicants would otherwise be entitled.

CONCLUSIONS

In view of Applicants' amendments and remarks, the Examiner's rejections are believed to be rendered moot. Accordingly, Applicants submit that the present application is in condition for allowance and requests that the Examiner pass the case to issue at the earliest convenience. Should the Examiner have any question or wish to further discuss this application, Applicant requests that the Examiner contact the undersigned at (248) 292-2920.

If for some reason Applicants have not requested a sufficient extension and/or have not paid a sufficient fee for this response and/or for the extension necessary to prevent the abandonment of this application, please consider this as a request for an extension for the required time period and/or authorization to charge Deposit Account No. 50-1097 for any fee which may be due.

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